



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,709	09/07/2000	Annika Bjore	3525-96	6411

7590 11/25/2002

Nixon & Vanderhye  
1100 North Glebe Road 8th Floor  
Arlington, VA 22201-4714

EXAMINER

BERCH, MARK L

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application N .

09/623,709

Applicant(s)

BJORE ET AL.

Examiner

Mark L. Berch

Art Unit

1624

--The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

THE REPLY FILED 08 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See memo.

3. ☒ Applicant's reply has overcome the following rejection(s): obviousness-type double patenting.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-14 and 20-27.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: PTOL-892

Mark L. Berch  
Primary Examiner  
Art Unit: 1624

#### DETAILED ACTION

The amendment filed 11-8-02 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues that would require further consideration and/or search.

A. Making claims 22-24 dependent on claim 1 introduces a new problem, as claim 1 does not provide for such compounds in the first place. For example, claim 24 has the oxo at the top of the molecule; claim 1 does not permit this.

B. The quaternary ammonium claim language added to claim 1 is broader than the specification, which is limited to the C<sub>1-4</sub> alkyl ammonium salts.

The amendment will not fix point 2. Simply transferring the defective material from the specification to the claims accomplishes nothing. An alkyl group cannot be cyclic nor can it be unsaturated. Correct terminology must be used. Thus, such a group which is cyclic is called cycloalkyl; that is the term which must be used.

The amendment, if entered, and arguments would have taken care of points 1 (in claim 1, but not elsewhere, e.g. claims 22-24), 3, 4 (but note A above), 5-8, and the solvates issue. The Terminal Disclaimer took care of the obviousness-type double patenting rejection

The traverse of the enablement rejection for claim 21 is entirely unpersuasive. There is no evidence in the reference submitted that one can go from the methyl to ethyl, or from the propyl to the butyl or to the isopropyl or to the ethyl. Nor is the second argument persuasive either. Applicants have named no reagent which will do the


Art Unit: 1624

first step without destroying other parts of the molecule, let alone such feats as converting other alkyls e.g. ethyl to the nitro. Deletion of this step is suggested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch  
Primary Examiner  
Art Unit 1624

November 20, 2002